

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: GOGIA *et al.* Examiner: Manohar, Manu M.

Serial No.: 10/518,972 Group Art Unit: 4161

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For: PROCESS FOR THE PREPARATION OF FORMULATIONS OF  
VALACYCLOVIR HYDROCHLORIDE TABLETS

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT MAILED

June 26, 2008

In response to the Office Action dated June 26, 2008, Applicants elect, without traverse, Group I (Claims 1-21 and 41-43) and elect the species of Example 4 of the specification for Examination without disclaimer or prejudice.

The Applicants, while not traversing the Restriction Requirement, wish to point out certain inconsistencies in the Requirement. The Examiner has cited PCT Rules 13.1 and 13.2 in saying “[T]he species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The Composition of the tablet encompassed by the instant invention have already been described in the art for controlling viral infections. (WO 96/22082, Page 1, line 5-14 and example 2, listed in International Search Report. Accordingly, the claims do not provide a new inventive concept over the prior art and thus they lack of (*sic*) unity of invention” (Restriction requirement, page 4, 3<sup>rd</sup> full paragraph). Applicants disagree. The Applicants respectfully point out that the Examiner’s remarks relate to the patentability of Applicants’ invention rather than requiring restriction.

Applicants believe this is improper. As the Examiner has determined, Group I encompasses claims 1-21 and 41-43, of which claims 1, 19, 20 and 41 are independent. The common technical feature present in all these claims is that they are all related to compositions of a hydrated valaciclovir hydrochloride. Claims 2-18 and 43 depend from claim 1 directly or indirectly, claim 21 depends from claim 20, and claim 42 depends from claim 41. PCT Rule 13.4 permits dependent claims “claiming specific forms of the invention

claimed in the independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention", subject to PCT Rule 13.1.

As noted earlier, Applicants elect Group I and further elect Example 4 as the species for examination on merits. Applicants understand that the scope of the independent invention will encompass all compounds and compositions within the scope of the claim which fall into the same class and subclass as the elected compounds or compositions, but may also include compounds and compositions which fall in related subclasses. Applicants also understand that Examination will then proceed on the elected compounds or compositions and the entire scope of the invention (Group I) encompassing the elected compounds and compositions as defined by the Examiner's restriction requirement which is guided by common classification. Applicants reserve the right to file divisional applications on all non-elected subject matter of instant application. The Examiner is therefore requested to examine the elected claims immediately.

Authorization is hereby given to charge any fees deemed to be due in connection with this Response to Deposit Account No. 50-0912.

Respectfully submitted,

GOGIA et al.

By:



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Date: July 25, 2008

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